AF/3627
SGW

PTO/SB/21 (04-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/865,799
Filing Date	May 25, 2001
First Named Inventor	Lincoln Rodon
Art Unit	3627
Examiner Name	Gerald J. O'Connor
Total Number of Pages in This Submission: 20	Attorney Docket Number: 31175934.066006

ENCLOSURES (*Check all that apply*)

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] After Allowance communication to Technology Center (TC)
- [ ] Appeal Communication to Board of Appeals and Interferences
- [X] Appeal Communication to TC **Response to Non-Compliant Appeal Brief**
- [ ] Proprietary Information
- [ ] Status Letter
- [X] Other Enclosure(s) (please Identify below):

return postcard; cert. of mailing

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	BAKER & MCKENZIE LLP Margaret A. Boulware– Reg. No. 28,708
Signature	Margaret A. Boulware
Date	December 13, 2005

PTO/SB/92 (08-03)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Application No. (if known): 09/865,799 Attorney Docket No.: 31175934-066006

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on **December 13, 2005** .
Date

Signature

Kathleen Byrd
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Response to Non-Compliant Appeal Brief pursuant to 37 CFR §41.37 (18 pages);
Transmittal (1 page);
Certificate of Mailing; and
Return postcard.

Attorney Docket No. 31175934-066006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lincoln Rodon

Serial No.: 09/865,799

Filed: May 25, 2001

Title: TRAVEL VALUE INDEX

§
§ Art Unit: 3627
§
§ Examiner: Gerald J. O'Connor
§
§

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING 1.18

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Appeal Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: **December 13, 2005**

Signature: _____
(Kathleen Byrd)

RESPONSE TO NON-COMPLIANT APPEAL BRIEF PURSUANT TO 37 C.F.R. §§41.37

Appellants take this appeal from the March 8, 2005, Final Office Action in the above-identified application. A Notice of Appeal was filed on July 20, 2005. Appellants filed an Appeal Brief in connection with the Notice of Appeal on September 20, 2005. This brief is being submitted in Response to the Notice of Non-Compliant Appeal Brief mailed on November 21, 2005.

TABLE OF CONTENTS

1. **REAL PARTY IN INTEREST**

The real party in interest is Amadeus NMC Holding, Inc., having a place of business at 9250 N.W. 36th Street, Miami, Florida 33178.

2. RELATED APPEALS AND INTERFERENCES

Appellants know of no other appeal or interference that will directly affect, or be directly affected by, or that will have a bearing on the Board's decision in the pending appeal.

3. **STATUS OF CLAIMS**

Claims 1-5 are withdrawn. Claims 6-11 are rejected. Claims 6-11 are the claims on appeal. A copy of the pending claims is attached as Appendix A.

4. STATUS OF AMENDMENTS

An amendment to claim 9 was filed on May 6, 2005 and was entered by the Examiner in his Advisory Action dated May 11, 2005. There are no amendments pending.

5. SUMMARY OF CLAIMED SUBJECT MATTER

One aspect of the invention relates to a method for facilitating the selection of travel itineraries. Specification, p. 4, ll. 10-11. The method includes: (1) selecting a travel criteria; (2) defining a traveler profile containing preferences associated with the travel criteria; (3) deriving preference factors based on the traveler preferences; (4) initiating a query of at least one travel information database for itineraries matching the selected travel criteria; (5) calculating a travel value index for each travel itinerary using a travel value algorithm based on the preference factors; and (6) returning only itineraries where said travel value index satisfies a traveler defined travel value index threshold. Specification, p. 21, ll. 3-13 and Fig. 8.

6. **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

(a) **Claims 6-11 stand rejected under 35 U.S.C. § 103(a) as being obvious in light of U.S. Patent 4,862,357 (*Ahlstrom et al.*), in view of European Patent 1,076,307 (*Bunyan et al.*).**

7. **ARGUMENT**

Claims 6-11 stand rejected under 35 U.S.C. § 103(a) as being obvious in light of U.S. Patent 4,862,357 (*Ahlstrom et al.*), in view of European Patent 1,076,307 (*Bunyan et al.*).

The Appellants' claims pending on appeal are a unique method for facilitating selection of travel itineraries. Each traveler starts with a fixed optimal value and traveler preferences, as described below, are given a numeric value that are added or subtracted to the fixed optimal value to produce the travel value index. Only itineraries that meet the travel value index threshold are returned. ***Neither Ahlstrom et al. or Bunyan et al., alone or in combination, disclose a fixed optimal value nor an index threshold value, therefore, an obviousness rejection is not supported.*** The travel value index is calculated using travel criteria which are associated with defined traveler preferences. These preferences include a lowest fare multiplier, an available dates index, a non-stop service index, and an equipment type index. Neither Ahlstrom et al. or Bunyan et al. disclose an equipment type preference factor. The traveler preferences are defined and stored in a traveler profile. A query of at least one travel information database is initiated for itineraries matching the selected travel criteria with the preferences using an on-line search engine. Using a travel value algorithm, a travel value index is calculated. The calculation subtracts preference factors from and/or adds preference factors to a fixed optimal value of the travel value index depending on the criteria matching itineraries. Neither Ahlstrom et al. or Bunyan et al., alone or in combination, disclose a fixed optimal value. One of the features of the current invention is the only itineraries returned are those having a travel value index satisfying a traveler defined travel value index threshold. Neither Ahlstrom et al. or Bunyan et al., alone or in combination, disclose a threshold value being an index value of the travel value index. Since the prior art is remiss in teaching or disclosing all of the claimed elements, the Examiner has failed to establish a prima facie case of obviousness.

The Examiner has not established a proper prima facie case of obviousness. According to United States Patent Office procedure, "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness" MPEP § 2142 (emphasis added); *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of prima facie obviousness."); s*ee also, In re Glaug*, 283 F.3d 1335, 62 USPQ2d 1151 (Fed. Cir. 2002); *In re Rijckaert*, 9 F.3d 1531, 1532, 28

USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(i) **The prior art reference (or references when combined) do not teach or suggest all the claim limitations.**

Ahlstrom does not disclose the optimal value is fixed or the threshold value itineraries must surpass in order to be returned is an index value of the travel value index. See March 8, 2005 Office Action page 3. The Examiner combines Ahlstrom et al. (hereinafter "Ahlstrom") with Bunyan (hereinafter "Bunyan") which the Examiner characterizes as disclosing a similar method which includes the travel value algorithm is defined in a manner such that an optimal value for the travel value index is fixed and the threshold value itineraries must surpass in order to be returned is an index value of the travel value index. See March 8, 2005 Office Action page 4.

Applicant strongly disagrees that Bunyan discloses a fixed optimal value. Bunyan teaches the suitability rating is based on the location and the type of holiday. Nowhere does Bunyan disclose an optimal value of the suitability rating, whether the optimal value is fixed or not, or even how the suitability rating is calculated. There is discussion with regard to "weighting", and "positive" and "negative" preferences but no discussion of how the suitability rating is calculated from the customer preferences and/or opinions. The Examiner cites to col. 5, lines 20-23, which discloses "[c]ustomers are able to click on the suitability rating given to obtain a breakdown of how it was derived, i.e. which factors gave positive and negative ratings towards the overall suitability rating." There is no disclosure on how the overall suitability

rating is calculated; it is a sort of "black box" calculation with Bunyan disclosing the end value (overall suitability rating), things contributing to the end value (preferences/opinions), but not how the end value is derived. There is no disclosure or suggestion of a fixed optimal value from which preferences are added or subtracted.

Furthermore, Bunyan does not disclose a threshold value itineraries must surpass in order to be returned is an index value of the travel value index. Bunyan does not disclose a threshold value nor that it is an index value of the travel value index. Bunyan discloses if there are more than a "specified number" of suitable holidays, the customer can sort or filter using criteria, but this sorting does not affect the suitability rating. See col. 4, lines 49-52. There is no suggestion of a traveler defined "minimum" value the suitability rating must have to be returned to the traveler. The "specified number" disclosed in Bunyan is not a threshold value; even if it were, it is not an index value of the travel value index.

Thus, the deficiencies of Ahlstrom, namely not disclosing a fixed optimal value or a threshold value itineraries must surpass in order to be returned is an index value of the travel value index, are not overcome when combined with Bunyan. "...[W]hat must be found obvious to defeat the patent is the claimed combination" *Kimberley-Clark Corp. V. Johnson & Johnson*, 745 F.2d 1437, 1448, 223 USPQ 603, 609-610 (Fed. Cir. 1985) and the claimed invention is not found in the combination of Ahlstrom and Bunyan.

Furthermore, the claimed method derives preference factors including a lowest fare multiplier, an available dates index, a non-stop service index, and ***an equipment index*** based on traveler preferences. Ahlstrom discloses factors including elapsed flight time, ground transportation costs, airline preference, and preferred route. Ahlstrom does not teach or suggest the travel policy includes preferences for an equipment type index.

Bunyan is directed to a method of rating holidays based on user preferences and other users' feedback. Nowhere does Bunyan disclose or suggest deriving preference factors including an equipment index based on the traveler preferences.

The combination of Ahlstrom and Bunyan fails to disclose ***three limitations***, *i.e.* a fixed optimal value, the threshold value itineraries must surpass in order to be returned is an index value of the travel value index, and a preference factor for an equipment type index. Thus, the

rejection of the claims as obvious in light of Ahlstrom and Bunyan is improper. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), See MPEP § 2142.

(ii) **There is no suggestion or motivation, either in Ahlstrom or Bunyan themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings.**

Since Ahlstrom does not disclose the optimal value is fixed or the threshold value itineraries must surpass in order to be returned is an index value of the travel value index, the Examiner combined it with Bunyan which the Examiner alleges discloses the travel value algorithm is defined in a manner such that an optimal value for the travel value index is fixed and the threshold value itineraries must surpass in order to be returned is an index value of the travel value index. On page 4 of the Office Action dated March 8, 2005, the Examiner stated the combination is made "in order to not overwhelm the customer by bombarding the customer with too many results/itineraries at once by presenting only a manageable number of the best itineraries, and to facilitate an apples-to-apples comparison in travel value index between disparate itineraries or other travel options." "When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)" See MPEP § 2142.

The combination of Ahlstrom and Bunyan is not necessary to present only a manageable number of the best itineraries or to facilitate an apples-to-apples comparison. Ahlstrom does not overwhelm the customer by bombarding the customer with too many results/itineraries. Ahlstrom teaches "Program flow is next directed to test 174 where the number of fares already analyzed by the system is compared to a **preset** number to determine whether an adequate number of fares have been analyzed. Program flow is directed to test 120 of FIG. 4 if an adequate number of fares have been analyzed. Program flow is directed from test 174 to step 176 if more fares are to be analyzed." See col. 8, lines 38, 45. Furthermore, Ahlstrom does an "apple to apple" comparison of the itineraries. "Step 218 takes each of the flight/fare alternatives that passes initial screening, and scores each flight/fare structure according to the predetermined, stored travel policy. In particular, each flight/fare structure is scored with reference to elapsed flight time, ground transportation costs associated with the particular flight, particular airline

preference, route preference, and preweighted scoring of various flight/fare limitations." See col. 10, lines 58-66.

Therefore if the Examiner is combining the references "in order to not overwhelm the customer by bombarding the customer with too many results/itineraries at once by presenting only a manageable number of the best itineraries, and to facilitate an apples-to-apples comparison in travel value index between disparate itineraries or other travel options." See March 8, 2005 Office Action, page 4. There is no need for the combination since Ahlstrom already teaches presenting only a manageable number of the best itineraries (although not via a threshold value that must be surpassed) and facilitating an apples-to-apples comparison in travel value index between disparate itineraries or other travel options (dollar-to-dollar comparison).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP § 2143.01. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

(iii) **There was no reasonable expectation of success.**

The Applicant has shown there was no motivation to combine Ahlstrom and Bunyan and even if the references were combined, the combination would not produce the claimed invention. If the combination of references does not produce the claimed invention, than there is no reasonable expectation of success. Therefore, the basic criteria for establishing a prima facie case of obviousness have not been met.

Since the Examiner has not established a prima facie case of obviousness, the claims are allowable. There was no motivation to combine the references, Ahlstrom already had a method to limit the number of returned itineraries and had an apples-to-apples comparison of the itineraries. Combining the references does not correct the deficiencies of Ahlstrom. Bunyan does not disclose a fixed optimal value or a threshold value itineraries must surpass in order to be returned being an index value of the travel value index. Bunyan does not even disclose a

threshold value. Since Bunyan does not remedy the deficiencies of Ahlstrom, there is not an expectation of success. With all three indicia of obviousness not being met, the Examiner has not established a prima facie case of obviousness.

For the reasons set forth above, the appealed Claim 6 is not rendered obvious under 35 U.S.C. § 103(a) by Ahlstrom in view of Bunyan. As for dependent claims 7-11, although they recite independently allowable subject matter, these claims depend from claim 6 and are therefore allowable for at least the same reasons. If an independent claim is nonobvious under 35 U.S.C.§103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, the final rejection of these claims should be reversed.

The fee of $500.00 required by 37 C.F.R. § 41.20(b)(2) was previously submitted. The Commissioner is hereby authorized to charge Deposit Account No. 50-3420, reference 31175934-066006(MAB) for any additional fees inadvertently omitted which may be necessary.

Respectfully submitted,

Margaret A. Boulware

Margaret A. Boulware
Reg. No.: 28,708

Date: December 13, 2005

Baker & McKenzie LLP
Pennzoil Place, South Tower
711 Louisiana, Suite 3400
Houston, Texas 77002
(713) 427-5003
(713) 427-5099 (fax)

APPENDIX A: CLEAN COPY OF CURRENT PENDING CLAIMS

1. (Withdrawn) A computer system for hosting an on-line travel planning application containing a search value program to facilitate selection of travel itineraries, the computer system comprising:

a central processing unit; and

a storage unit connected to said central processing unit for storing said search value program thereon, wherein said search value program is configured to:

allow a traveler to select a travel criteria and to set traveler preferences therefore in a traveler profile,

derive preference factors including a lowest fare multiplier, an available dates index, a non-stop service index, and an equipment type index for said travel criteria based on said traveler preferences,

initiate a query of at least one travel information database for itineraries matching said selected travel criteria using an on-line search engine,

calculate a travel value index for each itinerary using a travel value algorithm that subtracts preference factors from, or adds preference factors to, or both, an optimal value of said travel value index depending on said criteria matching itineraries, and

return only itineraries where said travel value index thereof satisfies a traveler defined threshold.

2. (Withdrawn) The computer system according to claim 1, wherein said search value program is further configured to cancel before final completion of said query any itineraries that cannot satisfy said traveler defined threshold.

3. (Withdrawn) The computer system according to claim 1, wherein said search value program is a Web based application.

4. (Withdrawn) The computer system according to claim 1, wherein said search value program allows said traveler to select said travel criteria and set said travel preferences via the Internet.

5. (Withdrawn) The computer system according to claim 1, wherein said travel value algorithm is defined in a manner such that an optimal value for said travel value index is approximately 100 percent.

6. (Previously presented) A method for facilitating selection of travel itineraries, comprising:

selecting one or more travel criteria;

allowing a traveler to define traveler preferences associated with said travel criteria and storing said traveler preferences in a traveler profile;

deriving preference factors including a lowest fare multiplier, an available dates index, a non-stop service index, and an equipment type index for said travel criteria based on said traveler preferences;

initiating a query of at least one travel information database for itineraries matching said selected travel criteria using an on-line search engine;

calculating a travel value index for each itinerary using a travel value algorithm that subtracts preference factors from, or adds preference factors to, or both, a fixed optimal value of said travel value index depending on said criteria matching itineraries; and

returning only itineraries where said travel value index thereof satisfies a traveler defined travel value index threshold.

7. (Original) The method according to claim 6, further comprising canceling before final completion of said query any itineraries that cannot satisfy said traveler defined threshold.

8. (Original) The method according to claim 6, wherein said travel value algorithm is defined in a manner such that an optimal value for said travel value index is approximately 100 percent.

9. (Previously presented) The method according to claim 6, wherein said steps of selecting, allowing, deriving, and initiating are performed over the Internet using a Web browser.

10. (Previously presented) The method according to claim 9, further comprising allowing said traveler to modify said traveler preferences in real time over the Internet using said Web browser and repeating said deriving, initiating, calculating, and returning based on modified preferences.

11. (Previously presented) The method according to claim 9, wherein the traveler preferences include preferences involving fare, availability, service type, and equipment type.

APPENDIX B: EVIDENCE

Not applicable.

APPENDIX C: RELATED PROCEEDINGS

Not applicable.